

REMARKS

Claims 1, 3-10, and 12-20 are currently pending in the application. By this amendment, claims 1, 7, 8, and 19 are amended for the Examiner's consideration, and claims 2 and 11 are canceled. The above amendments do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided in the claims as originally filed and at Figures 1 and 2. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Previous Office Action Vacated

Applicants appreciate the consideration of the arguments presented on March 7, 2007, and the vacating of the Office Action dated December 7, 2006. This response addresses the outstanding Final Office Action dated April 13, 2007.

Amendment is Proper for Entry

Applicants submit that this amendment places the application in condition for allowance by rewriting claim 2 in independent form by amending independent claim 1 to include the subject matter of claim 2 and canceling claim 2, and by rewriting claim 11 in independent form by amending claim 8 to include the subject matter of claim 11 and canceling claim 11. As the Examiner has previously fully searched and considered the subject matter of claims 2 and 11, this amendment does not raise any new issues that would require further search and/or consideration, nor any question of new matter. Applicants submit that all of the pending claims are in condition for allowance for the reasons discussed below. Alternatively, Applicants submit that the instant amendment places the application in better form for appeal.

Information Disclosure Statement

The Final Office Action states that the Information Disclosure Statement filed on October 11, 2006 fails to comply with 37 CFR 1.98(a)(1). In a telephone conversation between Applicants' representative and Examiner Cajilig, the Examiner indicated that the PTO-1449 form had not been received.

Submitted herewith is a copy of the Electronic Acknowledgement Receipt received by Applicants for the response filed October 11, 2006. Document Number 3 (on the second page of the Electronic Acknowledgement Receipt) lists the Information Disclosure Statement, which Applicants submit included two pages of an Information Disclosure Statement and twenty two pages of a PTO-1449 form. The Electronic Acknowledgement Receipt provides proof that the PTO-1449 was submitted on October 11, 2006.

Also attached hereto is a courtesy-copy of the previously submitted PTO-1449 form. Consideration of the IDS is required under 37 C.F.R. 1.97(c) because the IDS was submitted after the mailing of a first office action on the merits but before the mailing of a final rejection or notice of allowance, and the fee of \$180.00 set forth in 37 C.F.R. §1.17(p) was paid.

Accordingly, Applicants respectfully request that the Examiner consider the documents cited in the IDS and indicate such consideration by returning an initialed and signed copy of the PTO-1449 Form with the next official communication.

Drawing Objection

The drawings are objected to for failing to comply with 37 CFR 1.83(a). More specifically, it is stated in the Office Action that the drawings fail to show the following features recited in the claims: depressions, which are spaced apart parallel to one another, of

claim 7; a plurality of spaced apart recesses provided along the bottom lip of the second longitudinal edge, of claim 12; the bottom lip of the second transverse edge having a plurality of spaced apart recesses, of claim 13; the plurality of recesses, of claim 14; the bottom lip has a plurality of spaced apart depressions, of claim 20. Even more particularly, the Examiner asserts that the recess 15 shown in FIG. 3 is shown as one continuous recess. This objection is respectfully traversed.

FIGS. 1 and 2 of the instant application show partial views of two building boards according to aspects of the invention. The partial view is taken perpendicular to a plane that passes through the recess 15. Thus, a portion of a single recess 15 is shown. The remainder of the plurality of recesses are depicted in the partial view as overlapping the single recess 15 that is partially shown. Thus, the plural spaced apart recesses are shown as overlapping in the partial view, and are not shown as one continuous recess.

Moreover, Applicants note that 37 CFR 1.83(a) allows that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).” Applicants submit that the spaced apart parallel recesses are disclosed in the description and claims such that their detailed illustration is not essential for a proper understanding of the invention. Thus, the graphical depiction of overlapping recess 15 satisfies the requirements of 37 CFR 1.83(a).

Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

35 U.S.C. §112 Second Paragraph Rejection

Claim 18 is rejected under 35 U.S.C. §112, 2nd paragraph. The Examiner asserts that the recitation “markings provided on a top side of the board and corresponding to spacing between beams” makes it unclear whether the invention is directed to a floor board or to the floor board and beams to which markings would correspond. This rejection is respectfully traversed.

According to MPEP §2173.02, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Claim 18 recites the building board of claim 8, further comprising markings provided on a top side of the board and corresponding to spacing between beams. Applicants submit that this subject matter is sufficiently described in the specification such that a person skilled in the art would understand what the claimed invention is when the claims are read in light of the specification and the teachings of the prior art. More specifically, in a non-limiting exemplary embodiment shown in FIG. 4 and described in paragraph [0023], the board 1 is shown with such markings 21.

Claim 18 positively recites the board and the markings. That the markings correspond to spacing between beams is a functional recitation that must be evaluated and considered, just

like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (see MPEP §2173.05(g)).

Thus, Applicants submit one ordinarily skilled in the art reviewing the original disclosure and pending claims would understand the instant invention and readily ascertain the scope of the invention. Therefore, Applicants submit the instant rejection of claim 18 is improper.

Accordingly, Applicants respectfully request that the rejection over claim 18 be withdrawn.

35 U.S.C. §102 Rejection

Claims 8 and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0079820 issued to Palsson et al. ("Palsson"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

Independent Claim 8

As previously discussed, the present invention relates to a building board made of OSB (oriented strand board) which can be laid on beams in order to form a subfloor. Non-limiting exemplary implementations of the invention provide an OSB building board for forming subfloors such that the boards can be reliably oriented parallel to one another and connected to

one another. Independent claim 8, as currently amended to incorporate the subject matter of now canceled claim 11, requires that a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel. More specifically, claim 8 recites *inter alia*

... a first longitudinal edge having a tongue;
a second longitudinal edge opposite the first longitudinal edge and having a groove bounded by a top lip and a bottom lip;
...
wherein a front edge of the tongue of the first longitudinal edge comprises a bevel and a recess formed in the tongue adjacent to the bevel,
the bottom lip of the second longitudinal edge has a concave recess over its length, and
the tongue of the first longitudinal edge has a convex underside which corresponds to the concave recess.

Palsson does not contain this combination of features. Instead, Palsson shows a tongue 11 with a convex underside; however, the front edge of the tongue does not include a bevel and a recess adjacent the bevel (FIGS. 1 and 2). The Examiner impliedly agrees that Palsson does not show this combination of features, since the Examiner did not previously reject claim 11 under §102 in view of Palsson.

Claim 16 depends from allowable claim 8, and is allowable at least for the reasons discussed above with respect to claim 8.

Accordingly, Applicant respectfully request that the §102 rejection of claims 8 and 16 be withdrawn.

35 U.S.C. §103 Rejections

Claim 1 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson.

Claims 1, 2, and 11 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent No. 6,682,254 issued to Olofsson.

Claims 3, 6, and 19 were rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2002/0056245 issued to Thiers

Claims 4 and 5 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2003/0035921 issued to Kornicer

Claim 7 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 2, and further in view of U.S. Patent No. 3,474,425 issued to Hall.

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Thiers.

Claims 12-14 and 20 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Hall.

Claims 15 and 17 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Kornicer.

Claim 18 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent No. 6,012,255 issued to Smid.

These rejections are respectfully traversed for the following reasons.

Claim 1 in view of Palsson

Independent claim 1, as currently amended to incorporate the subject matter of now canceled claim 2, requires that a tongue of the longitudinal edge have a convex underside, a bevel, and a recess adjacent the bevel. More specifically, claim 1 recites *inter alia*

... wherein the tongue on the longitudinal edge comprises a bevel and a recess adjacent the bevel, and ...

wherein the groove on the longitudinal edge is bounded by a top lip and a bottom lip, the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, and the tongue has a convex underside which corresponds to the recess.

Palsson does not disclose or fairly suggest this combination of features. Instead, Palsson shows a tongue 11 with a convex underside; however, the tongue does not include a bevel and a recess adjacent the bevel (FIGS. 1 and 2). The Examiner impliedly agrees that Palsson does not show this combination of features, since the Examiner did not previously reject claim 2 under §103 in view of Palsson alone.

Accordingly, Applicant respectfully request that the §103 rejection of claim 1 be withdrawn.

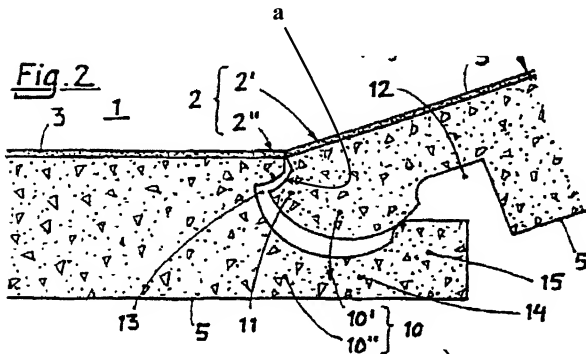
Claims 1, 2, and 11 in view of Palsson and Olofsson

Independent claim 1 recites, in pertinent part, that a tongue of the longitudinal edge has a convex underside, a bevel, and a recess adjacent the bevel. Applicants submit that no proper combination of Palsson and Olofsson discloses or suggests this combination of features.

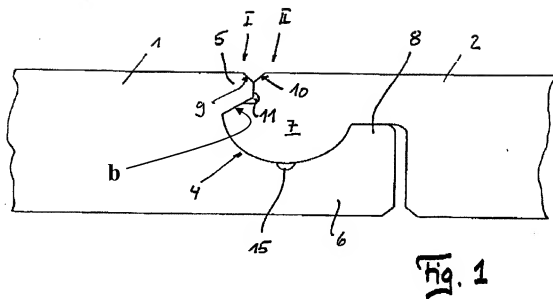
The Examiner asserts that Palsson discloses a tongue 11 having a convex underside and a bevel. The Examiner acknowledges that Palsson does not disclose a recess adjacent the bevel. Applicants agree that Palsson does not disclose a recess adjacent the bevel. However, the Examiner is of the opinion that Olofsson discloses a tongue having a recess adjacent a

bevel, and that it would have been obvious to modify Palsson in view of Olofsson. Applicants respectfully disagree.

Contrary to the Examiner's assertions, Palsson does not disclose a tongue having a convex underside and a bevel. Palsson shows a first edge 2¹ having a tongue 11 that includes a convex underside, as shown in FIG. 2 reproduced below.



The element "a" does not constitute a bevel, as described and recited in the claimed invention, because it exhibits a wavy (i.e., not flat or planar) contour. The term "bevel" is defined by <http://dictionary.reference.com/browse/bevel> as "the inclination that one line or surface makes with another when not at right angles," or "a surface that does not form a right angle with adjacent surfaces." Moreover, FIG. 1 of the instant invention, reproduced below, shows the bevel "b" as a flat (i.e., planar) surface.



Therefore, Palsson does not disclose a tongue having a convex underside and a bevel.

Furthermore, Olofsson does not disclose a recess adjacent to a bevel, as asserted by the Examiner. The Examiner asserts that Olofsson shows in FIGS. 5 and 6 a bevel (the not numbered angled flat surface at the distal end of the tongue 2) and a recess 6. Applicants acknowledge that Olofsson shows a bevel and a recess. However, the bevel is not adjacent the recess, as required by claim 1. As clearly seen in FIG. 5, the recess is located at a proximate end of the tongue 2 where the tongue 2 connects to the core, and the bevel is located at the distal end of the tongue. That is, the recess 6 and bevel are located at opposite ends of the tongue, with other features (i.e., wedges 3) disposed between the recess 6 and bevel. As such, the recess 6 is clearly not adjacent the bevel, as recited in claim 1. Therefore, no combination of Palsson and Olofsson discloses or suggests a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Regarding claims 2 and 11, these claims are canceled by the instant amendment, thereby rendering the rejection of these claims moot. Accordingly, Applicant respectfully request that the §103 rejection of claims 1, 2, and 11 be withdrawn.

Claims 3, 6, and 19 in view of Palsson, Olofsson, and Thiers

Claims 3, 6, and 19 depend from allowable claim 1, and are allowable for the reasons discussed above with respect to claim 1. Moreover, Thiers does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Thiers, like Palsson and Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claims 3, 6, and 19 be withdrawn.

Claims 4 and 5 in view of Palsson, Olofsson, and Kornicer

Claims 4 and 5 depend from allowable claim 1, and are allowable for the reasons discussed above with respect to claim 1. Moreover, Kornicer does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Kornicer, like Palsson and Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claims 4 and 5 be withdrawn.

Claim 7 in view of Palsson, Olofsson, and Hall

Claim 7 depends from allowable claim 1, and is allowable for the reasons discussed above with respect to claim 1. Moreover, Hall does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Hall, like Palsson and Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claim 7 be withdrawn.

Claims 9 and 10 in view of Palsson and Thiers

Claims 9 and 10 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Thiers does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Thiers, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claims 9 and 10 be withdrawn.

Claims 12-14 and 20 in view of Palsson and Hall

Claim 20

Independent claim 20 recites, in pertinent part:

... wherein the groove on the longitudinal edge is bounded by a top lip and a bottom lip, the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, the tongue has a convex underside which corresponds to the recess, and the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

The Examiner acknowledges that Palsson does not disclose a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. The Examiner asserts that Hall discloses a bottom lip B having a plurality of spaced apart recesses c configured to accommodate countersunk nail or screw heads, and that it would have been obvious to modify Palsson in view of the teachings of Hall. Applicants respectfully disagree.

Palsson shows, in FIGS. 1 and 2, a groove 13 formed by a bottom lip 14. The bottom lip 14 has a concave recess over its length. However, the bottom lip 14 does not comprise a

plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

Hall does not compensate for the deficiencies of Palsson with respect to claim 20 because Hall does not disclose a plurality of spaced apart depressions in a bottom lip that bounds a groove. Hall shows a tile for lining (i.e., facing) walls. The tile comprises a body portion A and a lip or flange portion B. Applicants acknowledge that the flange B comprises holes c for screws or nails (FIGS. 1 and 2). However, Hall's flange B does not constitute a bottom lip as recited in the claimed invention. That is, claim 20 recites a groove corresponding to a tongue, wherein the groove is bounded by a top lip and a bottom lip, wherein the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. Hall's flange B is not a bottom lip that bounds a groove that corresponds to a tongue. Instead, Hall's element B is merely a flange that extends from body A. Therefore, neither Palsson nor Hall shows a groove corresponding to a tongue, wherein the groove is bounded by a top lip and a bottom lip, wherein the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

Accordingly, Applicant respectfully request that the §103 rejection of claim 20 be withdrawn.

Claims 12-14

Claims 12-14 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Palsson and Hall do not show the features additionally recited in claim 12. That is, no proper combination of Palsson and Hall teaches or suggests a plurality of spaced apart recesses provided along the bottom lip of the second longitudinal edge.

As discussed above with respect to claim 20, Hall does not show a plurality of spaced apart recesses provided along the bottom lip of a tongue and groove connection. Hall's flange B does not constitute a lip that bounds a groove, as required by claim 8 from which claim 12 depends.

Accordingly, Applicant respectfully request that the §103 rejection of claims 12-14 and 20 be withdrawn.

Claims 15 and 17 in view of Palsson and Kornicer

Claims 15 and 17 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Kornicer does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Kornicer, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claims 15 and 17 be withdrawn.

Claim 18 in view of Palsson and Smid

Claim 18 depends from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Smid does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Smid, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claim 18 be withdrawn.

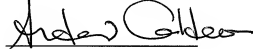
Other Matters

Claims 7 and 19, which previously depended from now canceled claim 2, are amended to depend from claim 1.

CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
Thomas GRAFENAUER

A handwritten signature in black ink, appearing to read "Andrew M. Calderon", written over a horizontal line.

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